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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,519	11/06/2003	Hugh C. Gardner	05485.105011	7372

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/701,519	Applicant(s) GARDNER ET AL.	
	Examiner Cheryl Juska	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 10-20 is/are pending in the application.
 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-6 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Interview Record OK</u> . |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed November 1, 2005, has been entered. Claim 1 has been amended as requested. Claims 7-9 are cancelled. Thus, the pending claims are 1-6 and 10-20, with claims 10-20 being withdrawn as non-elected.
2. Said amendment is sufficient to withdraw the 112, 2nd rejection set forth in section 9 of the last Office Action. Said amendment is also sufficient to withdraw the prior art rejection set forth in section 12 of the last Office Action. Specifically, Smith '220 does not teach or suggest a plain weave fabric in that the invention of Smith '220 is dependent upon a "non-traditional weave" that places multifilament weft yarns on the fabric face and monofilament weft yarns on the fabric back. Additionally, said amendment is sufficient to withdraw the rejection set forth in section 13 of the last Office Action, since said rejection is based upon a leno weave construction rather than a plain weave construction.

Terminal Disclaimer

3. The terminal disclaimer filed on November 1, 2005, in conjunction with the Power of Attorney filed November 16, 2005, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application No. 10/293,119 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite for the recitation “the secondary carpet backing increasing at least one of dimensional stability and delamination resistance of a carpet with the secondary carpet backing.” Said recitation is indefinite because it is unclear what the increase in properties are in comparison to. Is the increase in comparison to a carpet without any secondary backing or with an alternative secondary backing, such as a leno weave backing or a woven backing with a different fabric count and basis weight?

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-6 stand rejected under 35 USC 103(a) as being obvious over US 6,060,145 issued to Smith et al. as set forth in section 14 of the last Office Action.

As noted in the Interview Summary mailed September 15, 2005, applicant’s amendment is insufficient to overcome the Smith ‘145 rejection. Specifically, the limitation to a secondary carpet backing is merely descriptive of intended use. Additionally, Smith ‘145 clearly teaches a secondary carpet backing comprising a plain weave fabric. The limitation that the flat weave

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construction comprises a plain weave of a single layer is thereby met by Smith's teaching of a plain weave fabric. Said plain weave fabric is inherently a "single layer" itself. Note applicant's claim language only requires the plain weave fabric to being a single layer and not the entire secondary backing. Furthermore, Smith employs a "conventional secondary backing" (i.e., the plain weave fabric) for the base of its inventive modified secondary backing. This suggests to one that secondary backings of the claimed plain weave construction were "conventional" in the art or known prior to the Smith '145 invention.

Regarding the recitation "the secondary carpet backing increasing at least one of dimensional stability and delamination resistance of a carpet with the secondary carpet backing," said recitation is not given patentable weight at this time. In particular, applicant is merely claiming a carpet backing and not a carpet comprising said carpet backing. Therefore, the properties of the carpet construction (i.e., dimensional stability and delamination resistance) are not features of the presently claimed invention.

Response to Arguments

8. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive.

9. Applicant traverses the Smith '145 rejection by arguing that the reference requires a secondary backing having two layers (i.e., modified secondary backing) (Amendment, pages 9-10). However, as discussed above applicant's claim does not limit the "secondary backing" to being a single layer, but rather the claim recites "the flat weave construction comprising a plain

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weave of a single layer.” The *flat weave* construction *comprising* the plain weave of Smith ‘145 is a single layer. Therefore, applicant’s argument is found unpersuasive.

10. Additionally, applicant traverses the Smith ‘145 rejection by relying upon the Gardner Declaration under Rule 132 (Amendment, page 10, 2nd paragraph). However, said Declaration is insufficient to show unexpected results of the claimed invention over the teachings of the Smith ‘145 reference. Specifically, said Declaration, with data from the specification, establishes an improvement in properties of the present invention compared to leno weave secondary backings. Contrary to Gardner’s assertion, these leno weave fabrics are not “the closest prior art” for which to establish unexpected results. The closest prior art of record is the plain weave fabrics taught by Smith ‘145. Gardner implies that these fabrics “do not exist” (sections 12-14, pages 4-5). Smith ‘145 clearly prefers a leno weave fabric of 16 warps/in by 5 picks/in, but also explicitly teaches other fabrics having different counts and/or weaves, including plain weave fabrics, are suited for the invention. Thus, plain weave secondary backings, in general, exist in the prior art and are not merely “theoretical” as asserted by Gardner. As noted by Gardner, “Requiring applicant to compare claimed invention with polymer *suggested* by the combination of references relied upon in the rejection of the claimed invention under 35 USC 103 ‘would be requiring comparison of the results of the invention with the results of the invention.’” *In re Chapman*, 148 USPQ 11. In other words, the examiner is not requesting comparison of the present invention with the present invention *suggested* by the prior art (i.e., plain weave secondary backing having 12-24 warps/in by 10-20 picks/in with a basis weight of 1.5-7 osy), but rather with what is taught by the prior art (i.e., plain weave secondary backings in general). Hence, applicant has not shown unexpected results are achieved from optimizing the result

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effective variables such as yarn denier or width, basis weight, and/or yarn count and the above rejection over Smith '145 stands.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

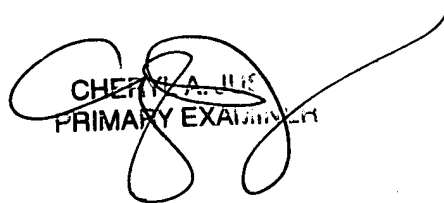
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. HILL
PRIMARY EXAMINER

cj
January 17, 2006